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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/441,458	11/17/1999	BRIAN T. MURPHY	06502.0260	4347

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EXAMINER	
EL HADY, NABIL M	

ART UNIT	PAPER NUMBER
2154	

DATE MAILED: 10/21/2003

22

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No	Applicant(s)	
	09/441,458	MURPHY ET AL.	
	Examiner	Art Unit	
	Nabil M El-Hady	2154	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *26 June 2003* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-27* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-27* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *19, 21* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

1. Claimed 1-27 are pending in this application.

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-27 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 of U.S. Patent No. 6,185,611. Although the conflicting claims are not identical, they are not patentably distinct from each other because both the instant application and U.S. Patent No. 6,185,611 disclose a distributed system having a lookup discovery service and lookup services with associated network services with client accessing the network services.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under th treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the

international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-13, and 16-27 are rejected under 35 U.S.C. 102(e) as being anticipated by Waldo et al. (USPN 6,185,611), hereafter "Waldo".

6. As to claims 1 and 19, Waldo discloses the invention including a method and computer-readable medium containing instructions for controlling a data processing system comprising receiving a request by a lookup discovery service to return locator information that facilitates access to a lookup service (col. 10, lines 60-63), and transmitting the request to the lookup service (col. 10, lines 63-67).

7. As to claims 6 and 24, the claims are rejected for the same reasons as claims 1 and 19 above. In addition, Waldo discloses that the request received by the lookup discovery service is transmitted by a client (Fig, 3A), and that the request is transmitted to at least one of a plurality of lookup services (inherent in col. 5, lines 47-50).

8. As to claim 13, the claim is rejected for the same reasons as claims 1 and 6 above. In addition, Waldo discloses, in a data processing system, a client computer, a lookup discovery service for accessing associated lookup services (Fig. 1 and Fig. 2), and a lookup service containing service stubs for accessing associated services (col. 7, lines 53-57). Waldo also discloses returning the locator information of the lookup service that satisfied the client's request (inherent in col. 10, lines 63-67).

9. As to claims 2, 8, 20, and 26, Waldo discloses receiving a request to register with the look up discovery service (col. 5, lines 60-63, 66-67).

10. As to claims 3, 9, 11, 21, and 27, Waldo discloses transmitting a multicast packet comprising a request to access the lookup service (col. 10, lines 47-63).

11. As to claims 4, 12, and 22, Waldo discloses transmitting a unicast packet comprising a request to access a lookup service (col. 10, lines 64-67).

12. As to claims 5, 7, 10, 23, and 25, Waldo discloses receiving lookup service locator information by the lookup discovery service, and transmitting the locator information to a client (col. 5, lines 63-66; col. 10, 47-59; and col. 13, lines 14-16).

13. As to claim 16, Waldo discloses returning the null value if no lookup service satisfying the client's request is found (col. 9, lines 23-25).

14. As to claim18, the claim is rejected for the same reasons as claims 1, 6, and 13 above. In addition, Waldo discloses a distributed system with a plurality of services (col. 4, lines 64-67, col. 5, lines 1-12) comprising a first server computer with a memory containing a lookup discovery service (102, Fig. 1, 214, Fig. 2), a second server computer with a memory containing a lookup service having stub (102, Fig. 1, 212, Fig. 2), and a processor (206, Fig. 2) for running the lookup service, and a client computer for transmitting a client request (col. 5, lines 8-19).

15. Claim 17 is rejected under 35 U.S.C. 102(e) as being anticipated by Miller (US 5,506,984).

16. Miller is cited by the applicant in IDS paper No. 21 filed 9/17/2003.

17. As to claim 17, Miller discloses a distributed system with a plurality of services (Figs. 5, 7, and 11) comprising a first server computer with a memory containing a lookup discovery service (e.g. 460, Fig. 7), a second server computer with a memory containing a lookup service having stubs (e.g. 490, Fig. 7), and a processor for running the lookup service (inherent in e.g. Fig. 7), and a client computer for transmitting a client request (450, Fig. 7), wherein the first server receives the client request and then transmits the request to at least one of a plurality of second servers (col. 12, lines 29-42), wherein the request provides locator information that provides access to a lookup service associated with the second server (col. 12, lines 2-6,20-22).

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

19. Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Waldo et al. (USPN 6,185,611), hereafter "Waldo".

20. As to claims 14 and 15, Waldo does not necessarily disclose transmitting a request for a plurality of lookup services or returning lookup service locator information for a plurality of lookup services. However, it would have been obvious to one skilled in the art at the time of the invention to exploit the characteristics of the Java programming environment where services appearing as objects, and the flexibility of the distributed system, to be able to transmit a request for a plurality of lookup services and receive service locator information for the plurality of lookup services.

21. Applicant's arguments filed 6/26/2003 have been fully considered but they are not persuasive.

22. In the remarks, applicants argued in substance that (1) Discovery servers in Waldo do not forward client requests to lookup services or to other discovery servers, (2) Waldo fails to disclose any suggestion or motivation to modify in the manner the Examiner suggests, and there is no reasonable expectation of success for implementing Waldo with Java programming.

23. Examiner respectfully traverses applicants' remarks.

24. As to point (1), in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., discovery servers forward client requests to lookup services or to other discovery servers) are not recited in the rejected claims 1, 6, 13, 18, 19, and 24. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). In addition, the new features (i.e., discovery servers forward client requests to lookup services or to other

discovery servers), which is amended to claim 17, is well known features in the art as discloses by many of the arts cited by the applicants in the latest files IDS paper No. 21 (see, for example Miller, US 5,506,984, col. 2-42).

25. As to point (2), the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Waldo discloses the utilization of Java programming environment to allow both code and data to be moved from device to device in a seamless manner within a distributed system. A service refers to a source, data or functionality that can be accessed by a user, program, device, or another service. The services appear programmatically as objects of the Java programming environment (see Waldo, col. 4, lines 11-63). This understanding offers enough motivation and success to one skilled in the art at the time of the invention to exploit the characteristics of the Java programming environment where services appearing as objects, and the flexibility of the distributed system, to be able to transmit a request for a plurality of lookup services and receive service locator information for the plurality of lookup services.

26. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

27. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nabil M El-Hady whose telephone number is (703) 308-7990. The examiner can normally be reached on 9:00 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Meng-Ai T An can be reached on (703) 305-9678. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Nabil El-Hady, Ph.D, MBA
Primary Patent Examiner
October 20, 2003